

REMARKS

Applicant respectfully requests reconsideration of this application. Claims 19-21 and 23-57 are currently pending in this application. Claims 19, 23-26, 28, 30, 32, 35, and 36 are amended. Claims 40-57 are new. No new matter has been added.

35 U.S.C. § 112 Rejections

Claims 23-27, 30-31, 36-38 are rejected under 35 U.S.C. § 112 first paragraph, as failing to comply with the written description requirement.

In rejecting the above claims under the first paragraph of 35 U.S.C. § 112, the Examiner alleges that the term “computer readable medium” includes air, wireless transmission, and various types of energies that can store information. The Examiner further asserts that the specification does not describe how the claims are related to “computer readable medium” and further alleges that the claims are not consistent with the subject matter of the specification and allegedly covers “new subject matter”, according to the Examiner.

The current law governing the written description requirement states that to satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. *Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306, 1319, 66 USPQ2d 1429, 1438 (Fed. Cir. 2003). The subject matter of the later claim need not be described literally or “in haec verba” in order for the specification to satisfy the description requirement. *In re Lukach*, 442 F.2d 967, 969, 169 USPQ 795 (CCPA 1971).

The specification clearly supports the claim language, “*A computer readable medium having stored thereon instructions for causing a computer to perform a method....*”. At least the following portions of the specification, in conjunction with at least Figures 1 and 2, clearly describe (and hence provide a written description of) such a computer readable medium. For example, page 9, line 24- page 10, line 2 states:

“*FIG. 1 illustrates generally one example of a computer system incorporating the invention. Referring thereto, the computer system 100 comprises a bidirectional system bus 102 interconnecting a processor 104 such as a central processing unit (CPU), memory 106, one or more output devices 108 and one or more input devices 110. The memory 106 typically comprises random access memory (RAM) for temporary storage of information and/or read only memory (ROM) for permanent storage.*

“*Optionally, the computer system includes a mass storage unit 112 such as a disk drive which is connected either directly or indirectly to the system bus 102. For descriptive purposes, the memory 106 and the mass storage unit 112 are collectively referred to as "storage" when data can be stored in any type of data storage unit.*” (Emphasis added).

From the above quoted passage, numerous references are made to the “memory” and “mass storage unit” which are clear examples of a computer readable medium. Contrary to the Examiner’s rejection, there is no mention of “air, wireless transmission, or various types of energy” as implied by the Examiner. Thus, the scope of the claim is clearly defined and readily understandable by one skilled in the art.

Furthermore, page 11, lines 9-12 state:

“*The software 130 is stored in memory 106 or stored in mass storage unit 112 and then loaded into memory when executed. The software 130 includes an operating system 132 for controlling and coordinating the computer system 100.*”

Again, it can be seen that these portions of the specification describe a computer readable medium (e.g. memory 106 and/or storage unit 112) that has stored instructions to cause the computer to perform the methods described in the application.

One skilled in the art can reasonably understand that memory and mass storage units are clearly described in the specification in at least the above quoted sections. The above quoted sections of the specification amply indicate that Applicants intended to use the terms "memory" and "mass storage unit" to cover any existing and future developed types of computer readable medium.

Thus, at least for the foregoing reasons, claims 23-27, 30, 31 and 36-38 comply with the written description requirement under the first paragraph of 35 U.S.C. § 112.

Claims 23-27, 30-31, 36-38 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Specifically, the Examiner rejects the above claims alleging that the "computer readable medium" is unknown and therefore indefinite.

However, mere breadth in a claim is not indefiniteness as supported by case law. See *In re Miller*, 441 F. 2d 689, 169 USPQ 597 (CCPA 1971). MPEP 2173.04 states:

"If the scope of the subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be a scope different from that defined in the claims, then the claims comply with 35 U.S.C. 112, second paragraph." (Emphasis added).

The scope of the subject matter embraced by the claims is clear as described at least on page 9, line 24 - page 10, line 2, and page 11, lines 9-12 of the specification. Therefore, the claims comply with 35 U.S.C. 112, second paragraph, because the scope of the subject matter embraced by the claims is clear in light of the specification.

Applicant, accordingly, respectfully requests withdrawal of the rejections of claims 23-27, 30-31, 36-38 under 35 U.S.C. § 112, second paragraph.

35 U.S.C. § 101 Rejections

Claims 23-27, 30-31, 36-38 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

MPEP 2106.01 states:

"When functional descriptive material is recorded on some computer readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized." (Emphasis added).

Thus, applicant's "computer readable medium" is statutory. Contrary to the Examiner's assertion, applicant has not admitted that the computer readable medium is non-statutory subject matter.

Applicant, accordingly, respectfully requests withdrawal of the rejections of claims 23-27, 30-31, 36-38 under 35 U.S.C. § 101.

35 U.S.C. § 102 Rejections

Claims 23, 28-31 are rejected under 35 U.S.C. § 102(b) as being anticipated by Hamakawa et al. (hereinafter "Hamakawa"), "Object Composition and Playback Models for Handling Multimedia Data", Proceedings of the first ACM International Conference on Multimedia, Pages: 273-281, August 1993.

Hamakawa is related to an approach to constructing multimedia data. Users set individual media data, such as video, audio, etc., on a timeline scale as shown in Figure 1. Users are also given the ability to edit the time based multimedia data. Hamakawa states:

"Without special OS support such as real-time scheduling, our library can achieve accurate playback rate for sampled data such as digital video. This is implemented simply by calling context's playback task method very frequently (about 10 times as actual frame rate). On each playback task method invocation, the context object checks current real time by the gettimeofday system call and decides which frame in the video should be displayed." (Emphasis added).

As shown by the above quote, Hamakawa is completely unrelated to the development of content as now required by the claims. Secondly, Hamakawa is primarily drawn to a playback system and allows a user to playback frames, where the frames are selected based on the a "gettimeofday" system. However, Hamakawa is unrelated to recording a user's actions that satisfy a specified criteria and then playing back a sequence of those user actions during the development of software content. In Hamakawa, the user is simply invoking a playback feature but does not select a specified criteria and then play back user actions.

Furthermore, applicant respectfully submits that a multimedia frame is not an "action" as required in the claims. Thus, each and every limitation required by the claims is not met.

Applicant, accordingly, respectfully requests withdrawal of the rejections of claims 23, 28-31 under 35 U.S.C. § 102(b) as being anticipated by Hamakawa.

Claims 19-21, 23-39 are rejected under 35 U.S.C. § 102(b) as being anticipated by Hardman et al. (Hardman), “Structures Multimedia Authorizing”, Proceedings of the first ACM International Conference on Multimedia, Pages: 283-289, August 1993.

At least claim 19 requires, “receiving one or more user events during the development of the software content; determining which events and sequences of events constitute actions;” (Emphasis added). As emphasized, the actions are actually comprised of user events during the development of software content and it is determined which events constitute actions because some events may be irrelevant and extraneous.

Hardman is generally a user interface for constructing and playing multimedia presentations. Hardman describes nodes containing children shown in a nested structure in Figure 3. The left column, paragraph 5, on page 286 of Hardman et al. states:

“Within the hierarchy view the author can select any object (data node or composite node) and cut, copy or paste it, or interrogate it for more information, such as the object’s attributes. Examples of attributes are : node, name, data file referred to, channel used, explicit duration, comment, highlight colour.”

Hardman allows the selection and editing of an object but does not disclose a determining of which events are “actions” and recording the determined actions during the development of the software content as required by the claims.

Furthermore, there is no determining of whether an explanation accompanies an action shown in Hardman during the development of the software. Thus each claim limitation is not met.

Applicant's invention has at least one benefit in that a novice author can learn how to create and modify multimedia products by seeing how other authors tackle the task of creating multimedia products. Hardman is completely unrelated to this objective and does not show the claim limitations required.

Applicant, accordingly, respectfully requests withdrawal of the rejections of claims 19-21, 23-39 under 35 U.S.C. § 102(b) as being anticipated by Hardman.

Applicant respectfully submits that the present application is in condition for allowance. If the Examiner believes a telephone conference would expedite or assist in the allowance of the present application, the Examiner is invited to call the undersigned at (408) 720-8300.

Please charge any shortages and credit any overages to Deposit Account No. 02-2666. Any necessary extension of time for response not already requested is hereby requested. Please charge any corresponding fee to Deposit Account No. 02-2666.

Respectfully submitted,

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Examiner: Vo, Ted T
Art Unit: 2191